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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/599,166	09/21/2006	Graham David Barrett	L+C-41325	5238
116 7590 11/29/2009 PEARNE & GORDON LLP 1801 EAST 9TH STREET SUITE 1200 CLEVELAND, OH 44114-3108				
EXAMINER EASTWOOD, DAVID C				
ART UNIT		PAPER NUMBER		
3731				
MAIL DATE		DELIVERY MODE		
11/20/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/599,166

Applicant(s)

BARRETT, GRAHAM DAVID

Examiner

DAVID EASTWOOD

Art Unit

3731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 September 2009.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5, 6, 8, 10, 11, 14, 16 and 30-38 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-3, 5, 6, 8, 10, 11, 14, 16 and 30-38 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 21 September 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-544)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. Receipt is acknowledged of applicant's amendment filed 9/18/2009. Claims 4, 7, 9, 12-13, 15 and 17-29 have been canceled without prejudice. Claims 1-3, 5-6, 8, 10-11, 14, 16, and 30-38 are pending and an action on the merits is as follows.

Applicant's arguments with respect to claims 1-3, 5-6, 8, 10-11, 14 and 16 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. Claims 1-3, 5-6, 8, 10-11, 14 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maaskamp et al (US 6013046) (hereafter referred to as Maaskamp) in view of Murry et al (US 3990452) (here after referred to as Murry).

Regarding Claim 1-3, 5-6, 8, 10-11, 14 and 16, Maaskamp discloses a phacoemulsification needle (10) capable of use in bimanual phacoemulsification procedures comprising a rod member (12) arranged for transmission of ultrasonic energy to an ocular substrate to effect emulsification thereof, and a hollow tube member (20) having an inner surface defining a lumen arranged for aspiration of emulsified ocular material, the hollow tube member being disposed about the rod member, the rod member having a distal end and a proximal end and the hollow tube member having a distal end and a proximal end, the rod member is concentric with a central longitudinal axis of the lumen (Figure 3), the rod member is of uniform cross section throughout its length (Figure 3), the rod member (12) is of circular, oval or polygonal shape in cross section (Figure 4), the hollow tube member (20, 22, 24, 26) is circular or oval in cross section (figure 4 item 26), the hollow tube member has an outer surface and the outer surface and the inner surface define an annular wall (Figures 3), the annular wall is of uniform thickness throughout (Figure 3 item 26), the hollow tube member has distal and proximal portions formed of relatively rigid metallic material whilst a mid section of the hollow tube member is formed of relatively flexible plastics material (Column 3 lines 13-20), the hollow tube member has a rubberized exterior or a flexible sleeve applied to an exterior surface thereof to reduce wound leakage (Column 3 lines 61-63). Maaskamp fails to disclose the rod member is solid throughout. However, Murray discloses a solid ultrasonic needle, solid between the distal and proximal ends thereof (fig. 18-20) (C5 L62-66). It would have been obvious to one of ordinary skill in the art at the time of invention to modify the invention of Maaskamp with the solid needle as disclosed by

Murry. Doing so would provide a member with a higher tensile strength able to withstand a greater frequency of ultrasonic vibration.

5. Claims 30-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maaskamp et al (US 6013046) and Murry (US 3990452) as applied to claims 1-3, 5-8, 10-11, 14 and 16 in view of Banko (US 6299591)(hereafter referred to as Banko).

Regarding claims 30-38, the invention of Maaskamp and Murray discloses the rod member (12) is concentric with a central longitudinal axis of the lumen (lumen of tube 20) (fig. 3), the proximal end of the rod member is connected to an enlarged hollow proximal extension (18), the enlarged proximal extension extending outwardly of the rod member and engaging with the tubular member(20) (fig. 3), the enlarged proximal extension being apertured (C 2 L59-61) so that aspirated material from the lumen is able to (capable of passing) pass into proximal extension of the rod member and the claimed invention except for a hollow cup-shaped member has a base which is abutted to the distal end of the rod member, the distal end of the hollow tube member being mounted about the cup-shaped member, and the cup-shaped member being apertured so that aspirated material is able to pass from the cup-shaped member into the lumen. However, Banko discloses a hollow cup-shaped member (distal end of 16) has a base (portion of 16 proximal the distal cup portion) which is abutted to the distal end of the rod member (fig. 7a), a distal end of a hollow tube member (92) being mounted about the cup-shaped member (16), and the cup-shaped member being apertured (18) so that aspirated material is able to pass from the cup-shaped member into the lumen. It would

have been obvious to one of ordinary skill in the art at the time of invention to modify the invention of Maaskamp and Murry with the distal cup shaped member as disclosed by Banko. Doing so would provide a larger vibrating surface area increasing the amount of cavitation created by the tips vibration.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **DAVID EASTWOOD** whose telephone number is (571)270-7135. The examiner can normally be reached on Monday thru Friday 9 a.m. to 5 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan Nguyen can be reached on (571)272-4963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/DAVID EASTWOOD/
Examiner, Art Unit 3731

/Anhtuan T. Nguyen/
Supervisory Patent Examiner, Art Unit 3731
11/19/09